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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/170,656	10/14/1998	SURESH JEYACHANDRAN	35.C13009	7028

5514 7590 11/26/2003

FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/26/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/170,656

Applicant(s)

JEYACHANDRAN ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003 and 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21,23,24,27-30,32,33 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21,23,24,27-30,32,33 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Prosecution Application***

1. The request filed on April 1, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/170,656 is acceptable and a CPA has been established. An action on the CPA follows.

***Response to Amendment***

2. This Office action is responsive to applicant's AMENDMENT AFTER FINAL REJECTION, filed March 3, 2003. Claims 1-21, 23, 24, 27-30, 32, 33 and 36-38 are pending.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-21, 23, 24, 27-30, 32, 33 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,291,302 (Gordon et al.).

Regarding claims 1-19, Gordon et al. disclose an information processing apparatus comprising identification name designation means for designating an identification name (including at least one of an information name, an information transmitter name, and an information sender name) related to object information (originating machine's identification, destination machine's telephone number stored, read column 7, lines 4-13) by a user (subscriber places call to destination via SAFF system, read column 8, lines 4-16; originator and destination telephone numbers transmitted to destination SAFF in response to call, read column 8, lines 36-44);

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process designation means for designating a process (including at least one of reception, of transmission, and of printing) for said object information (fax message delivered to destination machine, read column 7, lines 15-20) by the user (user prompted to select desired choices by pressing particular numbers on keypad, read column 9, lines 47-63); setup means for setting up a command (including a command for issuing a notification that said designated process has been completed; or a command for performing a further process, such as printing or holding said object information, related to said object information) to be executed ("delivery record" created upon successful delivery and sent back to the originating machine as a fax document, read column 9, lines 1-15), by the user (disposition options selected by user via keypad, read column 10, lines 3-8); and execution means for executing the command set up by said setup means when the process designated by said process designation means is performed on the object information related to the identification name designated by said identification name designation means ("transaction file" which includes delivery record is sent back to originating machine as a fax document, read column 9, lines 1-15). The information processing apparatus further comprises time limit setup means for setting a time limit; inhibition means for inhibiting said execution means for executing a command when the time limit set by said time limit setup means has expired (upon failure to deliver fax message within a time limit, a "retry record" is transmitted back to originator (column 10, lines 16-35), as opposed to the above-mentioned delivery record); status designation means for designating the status of said apparatus; and permission means for permitting said execution means to execute a command when the

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status designated by said status designation means is established (when the status of the apparatus allows for successful reception of fax message, a delivery record is created, as mentioned above); and management means for deleting a command set by said setup means when the time limit set by said time limit setup means has expired (message and report retransmitted back to originator, then erased, read column 10, lines 9-13). Accordingly, apparatus claims 1-9, as well as corresponding method claims 10-18, are rejected. As for a storage medium which stores a program for performing the method steps as recited in claim 19, Gordon et al. provide software control as disclosed at column 19, beginning from line 22.

Regarding claims 20-38, Gordon et al. disclose an information processing apparatus comprising identification name designation means for designating by a user (subscriber places call to destination via SAFF system, read column 8, lines 4-16; originator and destination telephone numbers transmitted to destination SAFF in response to call, read column 8, lines 36-44), an identification name related to a first process, a performance of which is employed as an execution condition for a second process to be performed (user has option of selecting "failed-connection message disposition" choice, read column 10, lines 3-5); setup means for setting up by the user, together with the identification name related to the first process, the second process that is to be performed when the first process related to the identification name designated by said identification name designation means has been performed (menu of disposition options presented to user for selection with keypad, read column 10, lines 5-8); determination means for determining whether the first process related to the

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identification name designated by said identification name designation means has been performed (failure in delivery of message to a destination detected, read column 9, lines 16-35); and execution means for performing, when the performance of the first process is determined by said determination means, the second process that is set up with the identification name related to the first process (disposition option performed in accordance with selection by user, read column 10, lines 9-17). The information processing apparatus further comprises time period setup means for setting an effective time period; and inhibition means for inhibiting said execution means from executing a command at a time other than the time period set by said time period setup means (delivery of message not performed if user does not respond to choice within a time limit or after a suitable delay, read column 10, lines 9-17). Said designation means designates a status during which a specific process is to be performed (status being a failure in delivery of a message, and a specific process being a process which is selected by a user, as mentioned above). At least one of reception, of the transmission, and of the printing can be designated as the specific process (message may be resent to original destination or forwarded to another destination, read column 10, lines 14-17). At least one of a user name, of an apparatus, and of a process name can be designated as an attribute for the specific process (above-mentioned original destination and another destination are attributes for the disposition process). The setup means is capable of setting, as the process to be executed, at least one of a notification, of a printing, and of a holding process (message may be retransmitted back to originator with a report, read column 10, lines 9-11). The information processing apparatus is

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capable of executing, at least one of reading and printing of information (reports may be accumulated and delivered as a fax document, read column 10, lines 18-35).

Accordingly, apparatus claims 20, 21, 23, 24, 27 and 28, as well as corresponding method claims 29, 30, 32, 33, 36 and 37, are rejected. As for a storage medium which stores a program for performing the method steps as recited in claim 38, Gordon et al. provide software control as disclosed at column 19, beginning from line 22.

### ***Response to Arguments***

5. Applicant's arguments filed in response to the prior rejection of the above claims as set forth in pages 2-5 of the Office action dated October 1, 2002 have been fully considered but they are not persuasive.

Applicant asserts, on page 13, of AMENDMENT AFTER FINAL REJECTION that Gordon et al. teach sending a notification for all fax documents in accordance with a transmission result, in contrast to the present invention as recited in independent claims 1, 10, 19, 20, 29 and 38. According to these claims, a command set up by setup means (for setting up a command to be executed, by a user) is executed. However, as mentioned above, Gordon et al. state that a menu of disposition options is presented to the user for selection with keypad (column 10, lines 5-8). The keypad provides the means for setting up a command regarding disposition options to be executed, and thus provides the execution means or step recited in applicant's claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-

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4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
November 25, 2003